

Serial No.: 10/649,910
Amdt. dated 28 March 2007
Reply to Office Action of 29 December 2006

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REMARKS

The Office Action of 29 December 2006 removed the previously issued restriction requirement and included a new restriction requirement for the claims pending in the subject application. According to the Office Action, the claims are drawn to two groups: Group I, including claims 1-20; and Group II, including claims 21-22.

In response to the Office Action, claims 1-20 have been withdrawn by the present amendment to the claims; Applicant, however, reserves the right to file one or more divisional or continuation applications directed to the subject matter of these withdrawn claims.

Election

In response to the restriction requirement, Applicant hereby elects, with traverse, for further prosecution in the subject application the claimed invention of Group II (*i.e.*, claims 21-22, directed to processes/methods of destroying bacteria).

Arguments against Restriction

Applicant respectfully traverses the restriction requirement and, further, contends that the Examiner's grounds for the restriction requirement are erroneous. Because of this error, the restriction requirement itself is believed to be improper. Applicant therefore requests reconsideration and withdrawal of the restriction requirement.

For the restriction requirement, the Examiner cited a portion of MPEP § 806.05(e), which states that between claims directed to a process and apparatus for its practice, restriction is appropriate if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process.

In concluding that restriction between the identified groups was proper, the Examiner stated "[i]n this case the apparatus could be used to illuminate tissue to determine the degree of oxygen

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saturation of the blood therein.” Applicant submits that the rationale is erroneous, and therefore that the restriction requirement is improper.

In supplying the rationale for the restriction requirement, the Examiner failed to consider all of the limitations present in the pending claims. As explained below, the Examiner has either ignored the plain text of the claims at issue, or introduced *sua sponte* extraneous limitations to the claims. By doing so, the Examiner has failed to comply with the requirements of MPEP § 806.01, which requires that “In passing upon matters of double patenting and restriction, it is the claimed subject matter that is considered.”

Claims 1-20 are directed to near infrared laser systems used for the destruction of bacteria in a bacterial locale. Claim 11, representative of the system claims, recites the following:

A laser system for destroying bacteria in a bacterial locale, said system comprising:

- (a) a housing and a control;
- (b) a laser oscillator sub-system within said housing for causing the selective emission under said control of first radiation narrowly at a first wavelength range of 870nm and the selective emission under said control of second radiation at a second wavelength range of 930nm; and
- (c) a head for delivering said first radiation and said second radiation from said laser oscillator sub-system to the site of said bacterial locale;
- (d) said first radiation and said second radiation being adapted to generate a chromophore from said bacterial locale and being adapted to cooperate with said chromophore to destroy bacteria in said bacterial locale.

One skilled in the art, when reading claims 1-20 in light of the specification, would understand that these claims are directed to use of near infrared lasers producing infrared energy in two specific near infrared (NIR) wavelength ranges, invisible to the naked eye, to destroy bacteria at a bacterial locale (*e.g.*, infected tissue) or mitigate deleterious effects produced by such bacteria. The laser systems recited in claims 1-20 do not include detectors to detect any absorption of the near infrared energy in tissue irradiated by such radiation. Therefore, the Examiner’s supplied rationale

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for the restriction requirement, *i.e.*, that "the apparatus could be used to illuminate tissue to determine the degree of oxygen saturation of the blood therein," is based on elements not recited in the claims at issue.


Thus, the Examiner has either ignored the plain text of the claims at issue, or introduced *sua sponte* extraneous limitations not actually present in the claims. In either event, by doing so, the Examiner has failed to comply with the requirements of MPEP § 806.01, which requires that "In passing upon matters of double patenting and restriction, it is the claimed subject matter that is considered."

For the reasons stated above, the Applicant requests reconsideration and withdrawal of the restriction requirement. Please charge any fees which may be due, or credit any overpayment, to Deposit Account Number 50-1133. The Examiner is invited to telephone the undersigned attorney to discuss any aspect of this application or this response.

Respectfully submitted,

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